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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/812,216

03/29/2004

Luke Aram

1671-0295

3037

28078

7590

11/17/2006

MAGINOT, MOORE & BECK, LLP  
CHASE TOWER  
111 MONUMENT CIRCLE  
SUITE 3250  
INDIANAPOLIS, IN 46204

EXAMINER

SAN MIGUEL, ANITZA M

ART UNIT

PAPER NUMBER

3733

DATE MAILED: 11/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/812,216	Applicant(s) ARAM ET AL.	
	Examiner Anitza M. San Miguel	Art Unit 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 and 30-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 22-29 are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                                  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/26/2005</u> . | 6) <input type="checkbox"/> Other: _____   |

## DETAILED ACTION

### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-21 and 30-36, drawn to a guide system for resecting a bone, classified in class 606, subclass 87.
- II. Claims 22-29, drawn to method of resecting a bone, classified in class 606, subclass 79.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the method can be practiced with another apparatus such as a manual saw or without the need of alignment pins.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required

because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

During a telephone conversation with Paul J. Maginot on November 6, 2006 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-21 and 30-36. Affirmation of this election must be made by applicant in replying to this Office action. Claims 22-29 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Specification***

The disclosure is objected to because of the following informalities:

In the "Brief Description of the Drawings, Fig. 11, "taken along line 11-11 of Fig. 12" should be changed to - - taken along line 11-11 of Fig. 10 - -. Line 11-11 is clearly identified in Figure 10 and not in Figure 12.

In page 12, line 9 and 12, reference "16" describes both "the incisions" and "the tibia". However, reference "12" discloses "the tibia" (page 11, line 9)

In page 12, line 20, reference "22, 24" describes both "the pins" and "the holes" (page 12, line 6). However, reference "26,28" discloses "the pins" (page 12, line 12)

In page 17, line 3, 6, 11, and 17 reference "100" refers both to "tibia alignment guide block", "tibia alignment block", "tibia guide block" and "the block".

In page 28, line 19, reference "262" refers both to "distal end wall" and "cutting face" (page 28, line 22).

In page 31, line 8-9, reference "314" refers both to "side finger" and "distal end" (page 31, line 2). However, reference "316" refers to "the finger".

Appropriate correction is required.

### ***Claim Objections***

Claims 19-21 are objected to because of the following informalities:

In claims 19-21, line 1, "The device of claim 1" should be changed to - - The apparatus of claim 1 - - in order to be consistent with claims 2-18.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Mains et al. (Reference U.S. Patent "4,421,112").

Claims 1-18 and 30-36 are rejected under 35 U.S.C. 102(b) as being anticipated by Mains et al. (Reference U.S. Patent "4,421,112", cited on IDS filed on October 26, 2005).

Mains et al. (herein Mains) discloses a guide system comprising: a first and second alignment pin (12) configured to be inserted through one of the incisions into a bone in a first and second orientation respectively; a wire saw (52); and wherein the first and the second alignment pin (12) are configured and oriented to define a resection of reference (col. 2, lines 8-38). The wire saw (52) configured to be inserted through at least one of the incisions to be guided by the first and second alignment pins (12) while being moved to resect the bone (col. 2, lines 8-38). The first and second alignment pin (12) has a length sufficient that the first and second alignment pin (12) extends completely through the bone with one tip extending beyond the bone on the first side and the second tip extending beyond the bone on the opposite side (col. 4, lines 27-33). The resection surface of reference is a plane (col. 4, lines 57-68). The apparatus further comprises a guide block formed to include a first and second guide hole (col. 2, lines 51-54). The first and second guide hole being sized to receive a drill sized to form a hole in the sized to receive the first and second alignment pin. The second guide hole being oriented with respect to the first guide hole to define a plane (col. 2, lines 54-67). The guide block is formed to include a first and a second guide saw guide. The first and second saw guides being positioned to guide the saw along the resection plane of reference when the saw is received in the saw guides (col. 5, lines 45-60). The first alignment pin (12) is received in the bone and the first guide hole and the second

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alignment pin (12) is received in the bone and the second guide hole (col. 5, lines 4-34). The first and second saw guide, first and second guide hole define a plane (col. 3, lines 24-34). The guide block is formed to include a third guide hole extending through the block, sized to receive a drill sized to form a hole, and a third alignment pin (col. 3, lines 35-44). The apparatus further comprises a saw driver (col. 5, lines 48-49).

With regards to claims 13-18 and 30-36, Mains' device operates utilizing a saw guide placed over one pair of pins and an oscillating saw blade driven by a motor (col. 2, lines 45-49 and col. 5, lines 45-54) to make a cut along the pins and as defined by those pins. Also, the device comprises a saw frame (col. 3, lines 27-34). Similarly, the claimed invention utilizes a saw driver and a rotary drill (it appears to be powered by a motor) to penetrate and cut through the bone. The wire saw might have the advantage of cutting non-linear cuts while the oscillating blade may only cut straight. Both the wire saw and the oscillating blade perform the same function.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mains et al (Reference U.S. Patent "4,421,112").

Mains et al. discloses the claimed invention except for the first and second alignment pins being configured to allow insertion into the bone through an incision less than six centimeters long; less than about two centimeters long; and about one centimeter long. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Mains with the first and second alignment pins configured to allow insertion into the bone through incisions less than six centimeters long, less than about two centimeters long and about one centimeter long, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Dunn et al.; Wehrli; Hempel et al.; and Egger et al. are cited art of interest.

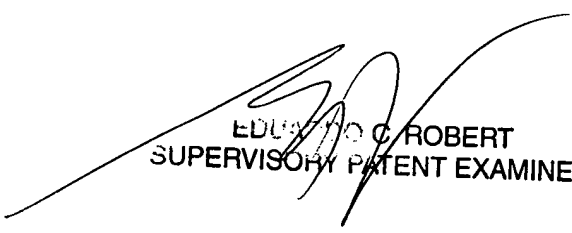
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anitza M. San Miguel whose telephone number is 571-272-3279. The examiner can normally be reached on 8:00 am - 5:30 pm EST (M-F).



If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ASM



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